

restriction requirement rather than an election requirement. The proper procedure is that if a generic claim is found patentable, the claims drawn to nonelected species are no longer withdrawn from consideration and must be examined. See MPEP §809.02(c). In this case, as indicated below, a generic claim is allowable over the applied art, so claims 5 and 6 must be restored to consideration and examined.

We turn now to the sole rejection.

Claims 1-4 and 7-9 are rejected under 35 U.S.C. 103(a) as being obvious over Zapol U.S. Patent No. 5,570,683. The office action at page 3 contends that Zapol administers in gas form nitric oxide or nitric oxide-releasing compound. Reconsideration is requested.

It is submitted that the rejection is in error because the claim language excludes administration of gaseous nitric oxide (See the application as filed at page 4, lines 16-18) and Zapol does not teach administering nitric oxide-releasing compound in gas form and rather leads away from this.

We turn now to the misinterpretation in the office action that provides the contention that Zapol teaches administering in gas form nitric oxide-releasing compound.

The language at column 4, lines 1 and 2 while reciting administering gaseous nitric oxide does not suggest administering gaseous nitric oxide-releasing compound. The term "gaseous" is used to modify only "nitric oxide". The term "gaseous" is not used to modify or describe "nitric oxide-releasing compound". It is submitted that consideration of what is set forth below suggests that this is purposeful.

Note that Zapol recites no nitric oxide-releasing compound in his description of this at column 5, line 59 - column 6, line 33, that is naturally a gas, that is Zapol recites only compounds that are naturally solids or liquids.

Moreover, Zapol, in describing administration of nitric oxide-releasing compounds (see column 6, lines 34-53) describes only administering them as solid particles or as liquid particles. Zapol nowhere discloses administration of nitric oxide-releasing compound which is naturally a gas or which is vaporized for administration.

Consider column 6, lines 34-53 of Zapol which is reproduced below.

Both the phosphodiesterase inhibitor compound and the nitric oxide-releasing compound selected for use in the method of the invention may be administered as a powder (i.e., a finely divided solid, either provided pure or as a mixture with a biologically-compatible carrier powder, or with one or more additional therapeutic compounds) or as a liquid (i.e., dissolved or suspended in a biologically-compatible liquid carrier, optionally mixed with one or more additional therapeutic compounds), and can conveniently be inhaled in aerosolized form (preferably including particles or droplets having a diameter of less than 10 μm). Carrier liquids and powders that are suitable for inhalation are commonly used in traditional asthma inhalation therapeutics and thus are well known to those who develop such therapeutics. The optimal dosage range can be determined by routine procedures by a pharmacologist of ordinary skill in the art. For example, a useful dosage level for SNAP would be from 1 to 500 μmoles (preferably 1-200 μmoles) per inhaled dose, with the number of inhalations necessary varying with the needs of the patient. (emphasis supplied)

It is submitted that the above-quoted paragraph suggests that a nitric oxide-releasing compound should not be administered as gas and thus leads away from the invention. Teaching or leading away is the very essence of unobviousness and compels finding of patentability and overcomes any *prima facie* case. In re Malagari, 182 U.S.P.Q. 549 (C.C.P.A. 1974) and In re Buehler, 185 U.S.P.Q. 781 (C.C.P.A. 1975).

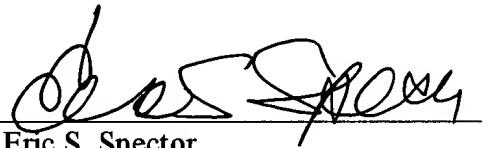
It is submitted that the sole rejection has been overcome, and since the generic claim is patentable over the applied art, Claims 5 and 6 must be restored to consideration and examined.

Consideration of claims 5 and 6 and allowance of all the claims is requested.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGED MADE

The paragraph beginning at page 1, line 3 has been amended as follows:

This application is a continuation-in-part of U.S. Application No. 09/390,215, filed on September 8, 1999, now U.S. Patent No. 6,314,956.